

56. The catheter of claim 55, wherein the polymeric material is a polyetheretherketone.

REMARKS

The applicant has filed this housekeeping amendment in the present reexamination and reissue application to provide a single set of claims for the merged proceeding. These claims are all the claims presently pending in the reexamination and reissue application.

Claims 1-6 are all of the originally patented claims. Reexamination of claims 1-6 was ordered on June 8, 1998, and no changes have been made to the claims under reexamination. Claims 1-6 were filed in the reissue application and remain pending, without amendments. These claims are therefore subject to the reexamination proceeding and the reissue proceeding.

Claims 7-17 were added to the original patent in a previous reexamination proceeding. The present reexamination order of June 8, 1998, on page 2, the third paragraph of text, states in part, "Claims 7-17 added by Ainsworth et al. in Reexam Number 90/004,602 do not form part of this Reexam since the reexamination certificate has not issued. Upon the issuance of the reexamination certificate, the claims therein will become part of the current reexam." The reexamination certificate in Reexam Number 90/004,602 has since issued. Essentially identical claims 7-17 were filed in the present reissue application. These claims are therefore subject to the reissue proceeding only, at present, though their status may change.

Claims 18-56 were filed in the present reissue application. At least some of claims 18-56 are broader than any claim in the original patent. 35 U.S.C. § 305 states in relevant part, "No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter." Therefore, claims 18-56 have not been entered, and must not be entered, as claims subject to the present reexamination proceeding. **This paper containing these claims is placed in the reexamination file only to ensure consistency of treatment in the merged reexamination and the reissue. Claims 18-56 are not under reexamination.**

Maintaining this distinction between claims 1-6, 7-17, and 18-56 is understood to comply with the Decision on Petition mailed on February 27, 2001. The Decision comments as follows on page 4: "The physical presence of the broadened claims in the reexamination file does not signify that broadened claims are present in a reexamination proceeding, but rather that broadened claims are present in a merged proceeding which permits such claims. The physical presence of the broadened claims in the reexamination is simply a display of the composite set of claims that exists in the merged proceeding." The Office is understood to be making a distinction between the physical presence of claims 18-56 in the reexamination file, so consistent claims can be maintained, and entry or examination of broadened claims in the reexamination, which is not possible under any circumstance.

The patentee also wishes to make of record a response to some of the statements made on page 8 in the Decision on Petition mailed on February 27, 2001, in the merged proceeding. The patentee believes the present reexamination file was lost when or shortly after the present reissue application was filed. The reexamination file was never found, and was reconstructed in the summer or fall of 2000. Therefore, the Office and the patentee had no way to merge the two proceedings or to allow the Examiner to share information in the reexamination file between 1998 and 2000. The cause of the present difficulty is not the patentee's failure to give notice. Had the notice been given on the day the reissue application was filed, the proceedings probably could not have been merged, in the absence of the reexamination file.

Also, not having ever prosecuted a reissue and reexamination involving the same patent simultaneously, the patentee's attorney was unaware of the requirement to provide information about concurrent proceedings in each proceeding. The patentee did not intentionally withhold information from the Office about the existence of the two proceedings. At the time the reissue application was filed, the patentee assumed that this reissue and reexamination respecting the same original patent, filed a few months apart, would routinely be assigned to the same Examiner, as was then the policy of the Office.

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